## REMARKS

Claims 1-25 are pending in the instant application after this amendment adds new claims 21-25. Claims 1, 4, 5, 12, and 13 are amended by this amendment in the same manner as presented in the Amendment after final filed on May 10, 2007. No new matter is introduced by the amendments and new claims, which find support throughout the specification and figures. In particular, the amendments and new claims are supported at least at page 13, lines 4-7, of the specification. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

The Office Action does not respond to Applicants' challenge of the Official Notice taken regarding the features of claims 14-18, as presented in the Amendments filed January 17, 2007. The Advisory Action of June 1, 2007 asserts that Applicants' challenge must provide a proper basis to cast reasonable doubt on the fact on which Official Notice is taken. Applicants therefore specifically point out the errors in the Office Action by stating why the noticed fact is not considered to be common knowledge or well-known in the art. In particular, Applicants assert that it is not common or well-known to insert retrieved advertising information in digital contents in which the digital contents include: information indicating that advertisements may be inserted, a header including at least a company name and a title, movie data including graphics data, the game program, object data, and a plurality of sets of texture data. Though each individual recited element may be known, Applicants respectfully submit that the conglomeration of these features in digital contents as recited in claim 1 is not common knowledge or well-known in the art. Therefore, Applicants respectfully request evidence in support of the Official Notice, as required by MPEP 2144.03 in response to our challenge of the Official Notice. Applicants have previously challenged the taking of Official Notice, and assert that the Examiner improperly

relies on personal knowledge, thereby undermining the prosecution process by depriving the Applicant of the opportunity to examine and analyze the references.

Additionally, Applicants challenge the taking of Official Notice with respect to claims 7, 9, 10, 19, and 20. Applicants submit that it is not common knowledge or well-known for advertisement information providing system to include means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results, as recited in claim 7. Likewise, Applicants submit that it is not common knowledge or well-known for an advertisement information providing system to include means for recording the transmission state of said advertisement information, with advertising fees being calculated based on said recording results, and the advertiser being billed for said advertising fees from said bank, as recited in claim 9. Similarly, Applicants submit that it is not common knowledge or well-known for an advertisement information providing system to provide said advertisement creating system with advertisement structure information containing at least portions and times regarding which advertisement insertion can be made, wherein said advertisement creating system provides said advertisement information providing system with advertisement information created based on said advertisement structure information and specified information from the advertiser.

Additionally, Applicants submit that it is not common knowledge or well-known in the art for retrieved advertising information to be inserted in a predetermined part of the digital contents, and the advertising information to be included in the predetermined part of the digital contents, as recited in claim 19. Likewise, Applicants submit that it is not common knowledge or well-known in the art for digital contents to include at least one vehicle operated by the user in which advertisement information is inserted on an exterior of the at least one vehicle, and the

advertisement information and the digital contents are dynamically presented to the user, as recited in claim 20.

Applicants therefore respectfully request that prior art be cited in regard to each of the above-referenced claims so that Applicants may have the opportunity to respond to prior art rejections.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5,835,087 to Herz (hereinafter referred to as Herz). Applicants respectfully traverse.

Claim 1 relates to an in-contents advertising method that includes, *inter alia*, activating in a user terminal in a game program by a user digital contents, and determining that the digital contents have been activated by the user. The method of amended claim 1 also includes ***counting a number of times that the retrieved advertising information is transferred.***

It is respectfully submitted that Herz does not disclose, or even suggest, that the system disclosed therein counts a number of times that the retrieved advertising information is transferred. Herz apparently indicates that advertisers typically purchase a right to include advertisements in a set (Herz; col. 40, lines 25-26). However, Herz does not disclose or suggest counting the number of times of updating the transmission record for advertising data. The instant specification describes the counting of the number of times of updating a transmission record for advertising data that is transmitted to a user terminal, and further describes that such a counting allows billing of an advertiser to be calculated based on the value (Specification; page 13, lines 4-7). Applicants respectfully submit that Herz does not disclose or suggest the feature of the amended claims, and therefore for at least this reason the claims are allowable.

Additionally, with respect to the digital content being activated in a game program, the Office Action asserts that the "game program" limitation, as compared to the news program of

Herz, is an obvious variation. However, the present invention significantly differs from Herz in that this invention relates to an in-contents advertising method or a digital contents distribution system, while Herz relates to a news clipping service that may deliver news articles (or advertisements and coupons for purchasables). Applicants maintain that the motivation to modify Herz, "to attract a younger audience", is improper. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The Office Action asserts that the motivation to modify the news service in Herz to a game program to attract younger users (Office Action; page 3, lines 4-8). However, as stated above, this conclusory reasoning is insufficient to support a claim of obviousness. Therefore it is respectfully submitted that Herz does not render obvious the claims.

Claims 2, 3, and 14 depend from claim 1 and are therefore allowable for at least the same reasons as claim 1 is allowable.

Claims 4, 5, 12, and 13 include features similar to those discussed above in regard to claims 1 and 2, and therefore, for at least the same reasons claims 1 and 2 are allowable, claims 4, 5, 12, and 13 are also allowable.

Claims 6-11 and 15-20 depend from one of claims 4, 5, 12, and 13, and are therefore allowable for at least the same reasons as their respective base claims are allowable.

Additionally, claim 19 recites that the digital contents include a moving image, the retrieved advertising information is inserted in a predetermined part of the digital contents, and the advertising information is included in the predetermined part of the digital contents. The Examiner takes Official Notice of digital contents being presented as moving objects. Applicants

respectfully challenge the taking of Official Notice, and respectfully request a citation to a prior art reference disclosing this feature, along with a proper motivation to combine such reference with Herz. Alternatively, Applicants respectfully request that the rejection be withdrawn.

Claim 20 recites that the game program is a driving game program, the digital contents include at least one vehicle operated by the user, the advertisement information is inserted on an exterior of the at least one vehicle, and the advertisement information and the digital contents are dynamically presented to the user. The Examiner takes Official Notice of game programs using vehicles and users being able to manipulate these features. However, this does not even allege that it is well known to change an exterior of a game vehicle to include advertising information. Furthermore, Applicants respectfully challenge the taking of Official Notice, and respectfully request a citation to a prior art reference disclosing this feature, along with a proper motivation to combine such reference with Herz. Alternatively, Applicants respectfully request that the rejection be withdrawn.

New claims 21-25 depend from one of claims 1, 4, 5, 12, and 13, and therefore each of these claims is allowable for at least the same reasons as their respective base claim is allowable. Additionally, each of these claims recites the feature of billing an advertiser for advertising fees calculated based on the number of times that the retrieved advertisement information is transferred. It is respectfully submitted that none of the prior art discloses or suggest this feature, and therefore for at least this additional reason, these new claims are allowable.

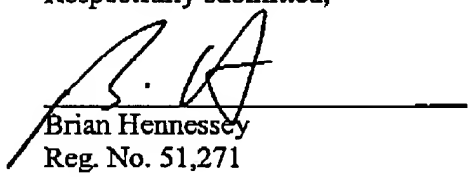
## CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner

should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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